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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/779,779
Filing Date: February 08, 2001
Appellant(s): GOLDSCHMIDT IKI ET AL.

Gordon R. Lindeen III
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 6th, 2008 appealing from the Office action mailed August 27th, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,446,261	Rosser	3-2002
6,614,987	Ismail et al.	9-2003
2006/0168620	Schein et al.	7-2006

Forsyth, Kevin "History Of the Delta Launch Vehicle: Delta, Satcom and the Cable Boom", published 11-20-02, source: <http://kevinforsyth.net/delta/satcom.htm>

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5, 7, 9-19, 21-22 and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (US PG Pub. 2006/0168620) in view of Rosser (US Pat. 6,446,261) and Ismail et al. (US Pat. 6,614,987)

With Regards to claim 1, 10 and 16, Schein discloses a method comprising:

Receiving an EPG at the electronic device (see [0026]);

Receiving a selection of entertainment program within the EPG from a user at the electronic device (see [0032], [0033]);

Schein discloses that when a user selects a "when else" option, the system searches the program information for other occurrences of that particular show. By searching for other occurrences, the system is determining whether multiple versions (occurrences) are available. See [0064], "*the system searches for other occurrences of GONE WITH THE WIND and indicates to the user if, when and where GONE WITH THE WIND will be played again*"

Identifying multiple available versions of the same selected entertainment program in the electronic programming guide when a user selects "when else" option (see fig. 3, [0034], [0035]).

Schein discloses that upon determining that there multiple versions of the same selected program, the system allows the user to either automatically record/tune one of

the multiple versions or simply notify the plurality of versions of the program (see [0032], “the user may wish to find out if the movie GONE WITH THE WIND is showing at other times such that the user may either automatically record the future presentation of GONE WITH THE WIND, automatically tune to the future presentation of GONE WITH THE WIND, or simply be aware that GONE WITH THE WIND will be showing at a future time”). Schein therefore discloses the step merely displaying the identified versions when no automatic tuning has been set to notify the user of the plurality of program occurrences.

Schein fails to disclose receiving user preferences at receiver and storing them at the receiver. Furthermore, while Schein discloses automatically tuning to one of the multiple occurrences (i.e. automatic program selection), fails to disclose selecting one of the multiple versions by comparing the identified characteristics to the received user preferences for entertainment program characteristics and selecting the program that has the most characteristics conforming to the user preferences.

Rosser discloses the step of receiving user preferences at a receiver (see column 4 lines 42-44) and storing user preferences at the receiver (see column 30 lines 50-51 “stores a continuously updated user version of a usage profile”). Rosser further notes broadcaster transmit content to viewer based on preferences indicated in viewer profiles thereby targeting different versions of programs based on the profile information. One such example of different versions may comprise alternative versions of programs that maybe edited to omit or replace offensive content. See column 14 lines 18-23. Rosser therefore evidence that alternative versions of the programs were

known at the time of the invention, wherein the versions differed in certain characteristics (e.g. rating) wherein Rosser teaches the method of selecting one of the multiple versions of a program by comparing the program characteristics to the user profile preferences in order to select the program that conforms most to the user preferences. Rosser is still silent on making the selection by the electronic device.

Ismail teaches the step of automatically selecting a program for recording by the receiver, when the program characteristics match user preferences. Priority scores for programs are determined by correlating user preference for program attributes and programs containing attributes. The program with the highest correlation (highest rating) of user preferences with program attributes is picked for recording. See column 9 lines 61-67 and column 10 lines 1-9. Furthermore, Ismail notes that user preferences are determined from category-value pairs (see column 3 lines 66-67) wherein one such category includes MPAARATING (see column 7 lines 14). Ismail therefore teaches the step of selecting a program for recording that best conform to the user preferences

All the claimed elements were known in the prior art. In particular, Schein discloses the method of identifying multiple occurrences of a program in the program guide wherein one of the future occurrences maybe automatically selected or recorded (see Schein: [0032], Rosser notes that alternative versions of a program exist wherein the version that best matches viewer's profile is selected, and Ismail teaches such a selection of program that is in conformance with viewer profile is selected by the receiver. One skilled in the art could have combined the elements with known methods with no change in their respective functions and the combination would have yielded

predictable results to one of ordinary skill in the art at the time of the invention. The motivation for combining the references would be to allow a user to indicate certain preferences and automatically select one of the alternative versions by the receiver thereby automatically selecting the version that best matches the viewer's preferences. Such alternative versions programs, wherein one alternative version maybe suitable for children or network TV, while the other is not, may vary only in their rating. Therefore version of the program comprising the MPAA rating that matches user's preference for such rating would result in a higher score than the version that does not match user's preference on the rating. In such a case, the modified system selects the version most closely resembling the user preferences for the entertainment program characteristics.

With further regards to claim 10, the methods are computer executable instructions stored in memory (28) and executed by a processor (26). See Schein: [0024] and [0038].

With regards to claims 2, 11 and 17, the modified system further comprises the step of identifying multiple versions of the entertainment program that start within a threshold period of one another (see Schein: [0038], step 402).

With regards to claims 3, 12 and 18, the multiple versions are provided on different transport media (i.e. DBS and cable), and the system further identifies information regarding the channel transport medium (see Schein: [0018]) and the selection comprises selecting based on the set of transport medium descriptive information (see Schein [0031]).

With regards to claims 4, 13, 19 the system comprises the step of identifying multiple versions that all start approximately at the same time. See Schein: [0038], step 402.

With regards to claims 5, and 14, Ismail discloses recording a program based on a rating scores is determined by correlating user preference for program attributes and programs containing attributes. The program with the highest correlation (highest rating) of user preferences with program attributes is picked for recording. See column 9 lines 61-67 and column 10 lines 1-9. Furthermore, Ismail notes that user preferences are determined from category-value pairs (see column 3 lines 66-67) wherein one such category includes MPAA RATING (see column 7 lines 14). In the modified system, it is noted that alternative version programs of exist, wherein one such alternative version maybe suitable for children while the other is not, the two versions varied only in their rating. Therefore version of the program comprising the MPAA rating that matches user's preference for such rating would result in a higher score than the version that does not match user's preference on the rating. In such a case, the modified system selects the version most closely resembling the user preferences for the entertainment program characteristics.

With regards to claims 7, 15, and 21, the identified characteristic for each of the multiple versions includes the channel transport medium. See Schein [0018].

With regards to claim 8, Rosser further discloses the step of identifying a user of an entertainment system (col. 15 lines 5-28), accessing user preferences for the identified user (col. 15 lines 28), and selecting content from versions of content based

on a comparison of the sets of descriptive information (col. 14 lines 50-60). As discussed above in claim 1, the modified system further selects one of multiple versions based on comparison of the identified characteristics to the accessed user preferences.

With regards to claim 9, the system comprises the step of identifying multiple versions in the EPG. See Schein: [0034], [0035].

With regards to claims 22, the system comprises the step of determining the user preferences by receiving preference information through manual inputs from a user. See Schein [0031], the step of "activating" and "deletion" require user intervention, and therefore are "manual inputs" from the user.

With further regards to claim 23 and 26, Rosser shows determining the user preferences by monitoring the behavior of the user (col. 8 lines 1-55, col. 9 lines 50-67, col. 12 lines 1-5).

With regards to claim 24, Rosser shows identifying a user of an entertainment system (col. 15 lines 5-28), accessing user preferences for the identified user (col. 15 lines 28), and selecting content from versions of content based on a comparison of the sets of descriptive information (col. 14 lines 50-60).

With regards to claims 25, the system comprises a user interface controller for receiving preferences through manual information inputs from a user. See Schein: [0024]

(10) Response to Argument

The examiner respectfully disagrees that the rejection should be reversed. Only those arguments having been raised are being considered and addressed in the

Examiner's Answer. Any further arguments regarding other elements or limitations not specifically argued or any other reasoning regarding deficiencies in a prima facie case of obviousness that the appellant could have made are considered by the examiner as having been conceded by the appellant for the basis of decision of this appeal. They are not being addressed by the examiner for the Board's consideration. Should the panel find that the examiner's position/arguments or any aspect of the rejection is not sufficiently clear or a particular issue is of need of further explanation, it is respectfully requested that the case be remanded to the examiner for further explanation prior to the rendering of a decision. See 37 CFR 41.50(a)(1) and MPEP 1211.

Appellant's arguments (see Brief page 9) stating that, "Examiner suggests that these other broadcasts of the same program may be different versions of the program" and that "While it is possible for the broadcasts to differ, such a possibility is nowhere suggested in the reference". Examiner respectfully disagrees with appellant's contentions. Firstly it should be noted that "different versions" can encompass inter alia, different instances of the program that is aired. In such a broad read of "version", Schein shows 5 instances of the program "GONE WITH THE WIND" that is aired in figure 3, and accordingly each such instance can be considered a "version" of the program that will be aired. As noted above in the rejection, Rosser discloses that alternative versions of the program wherein the program has been edited for different audiences may also be transmitted. See column 14 lines 18-23. Such alternative versions may therefore vary by their ratings. In addition to that, it is further noted that programs comprise attributes that characterize whether a program is a first run or

reruns see column 12 lines 8-15). In such an instance the program characteristics for a first run program would be different for a rerun or a syndicated version of that program. Furthermore, "History of the Delta Launch Vehicle" provides extrinsic evidence that "HBO...was a "pay television" service airing commercial-free unedited movies". All of these are evidence that it was well known in the art at the time of the invention for a particular program title to vary in their program attributes only (first run vs. rerun), vary in that they're aired unedited/edited (HBO vs. NBC version) or vary in that they are edited for different audience levels (by removing objectionable material to comply with FCC standards). Thus, there exists a specific need to alter and create different versions of the same film. For these reasons appellant's assertion (see Brief page 10) that "same movie might be available in stereo from one broadcaster and in full 7.1 channel Dolby True HD from another" are found unpersuasive. Furthermore, appellant attempts to argue that appellant's instant system varies in that they transmit different types of broadcast programs (one in stereo, one in 7.1 channel Dolby), wherein examiner notes that such arguments are directed over non-functional descriptive material that cannot render nonobviousness an invention that would have otherwise been obvious. Thus if the prior art suggests storing programs based on user preferences on a receiver, merely choosing a particular version when multiple versions exist would be presumed to be well within the level of ordinary skill in the art at the time the system was made.

It should also be noted that appellants arguments are attempting to use non-functional descriptive material to define over the prior art. The Court have said this is not proper in *in re Ngai* 367 F.3d 1336, 1339, 70 USPQ2D 1862, 1864 (Fed Cir 2004).

Appellants arguments (see Brief page 10) stating that, "Rosser does not explain how the broadcaster presents the intended version of a program" because "A whole program cannot be inserted using Rosser's system" and arguments further stating (see Brief page 13) that, "In order to adapt Schein and Rosser to perform the operations recited in the claims, (1) the channel number functions must be changed to function on a selected program of the type shown in Schein Fig. 3. (2) the centralized broadcaster functions must be adapted to work on demand in a user electronic device" have been noted. However the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Rosser is evidence that (i) that alternative versions of programming were well known in the art and (ii) when possible select the version that matches viewer profile characteristics. Ismail further teaches making program selection based on user profiles at the receiver. As such these teachings as a whole teach an improved method in automatic selection of a program when multiple versions exist, wherein the program is selected such that it best characterizes viewer's preference for that program.

Appellants arguments stating (see Brief, page 11) that, "There is nothing in Schein to suggest that these programs are different versions and Schein provides no insight as to how to handle different versions other than to just list them as if they are all

the same" have been noted. As noted above, the recited limitation of "different versions" is fairly broad and the office has given it reasonable weight in examining the claims. Furthermore, it is noted that appellant argues against each references individually, as exemplified by the above arguments and appellant's arguments (see Brief page 10) stating that, "This [Ismail] has nothing to say about selecting between different versions of a program" and appellants arguments (see Brief page 12) regarding Rosser stating that, "there is no mention that the claimed processed is applied. This process involves...a) receiving a selection b) identifying multiple versions c) determining whether the identified version are available, d) comparing the characteristics of the version to the user preferences and then selecting a version". One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, the teachings provided by Rosser provide insight as to how to handle different versions based on user preferences wherein Ismail further teaches how to handle user preferred program selections at the receiver.

Furthermore, appellant's arguments (see Brief page 12) stating that, "a) receiving a selection b) identifying multiple versions c) determining whether the identified version are available, d) comparing the characteristics of the version to the user preferences and then selecting a version" show that appellant construes the claim language to execute methods in the order they are recited in the claim language. MPEP 2111.01 (II) states that, "...it was improper to read a specific order into method claims where, as a

matter of logic or grammar the language of the method claims did not impose a specific order on the performance of the method steps". In this case method claim 1 does not require all the steps to be performed in a sequential order as they are recited. For example, the limitation "determining whether multiple versions are available" need not follow the step of "identifying multiple versions of the same selected entertainment program in the electronic programming guide".

Examiner further disagrees with appellant's statements (see Brief page 13) that, "the modifications would require some inventive skills". The references show that it was known in the art to broadcast alternative versions of a program, display a plurality of versions of a program in the EPG, distributing a version of a program that conforms to user's preferences as well as selecting programs at a receiver according to user's preferences. One of ordinary skill in the art would have been motivated to make the selection of one of multiple versions of a program more user friendly by incorporating user preference information thereby allowing the user's receiver to determine the best version for the user.

Furthermore, appellants arguments (see Brief page 15) , "the present invention recognizes that the assumption that thins are identical may no longer be valid....If the user wants a cleaned up version late at night, that can be selected. If the viewer wants the full measure of sex and violence on Sunday morning that can be chosen as well" attempting to distinguish instant invention apart from the references have been noted. While these features upon which appellant relies are not recited in the rejected claim(s), it is noted that Rosser suggests drawing inferences based on user's viewing patterns to

determine what demographics are viewing the different types of programming different times of the day. See column 8 lines 28-30 and lines 35-38. Therefore it would be well within the scope one of ordinary skill in the art to use these teachings so that the system chooses a clean version of the program during the day time when kids are likely to be present and using the offensive version when kids are not likely to be present. Furthermore examiner finds it remarkable that appellant suggests (see Brief page 15) that automatically selecting programs according user's preferences at a home receiver, i.e. "a user configurable program selection...in and of itself would be inventive" as Ismail bears clear evidence that it was well known in the art at the time of the invention for providing "a user configurable program selection" at a home receiver. As such examiner disagrees with appellant's statements.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Usha Raman/

Conferees:

/Christopher Kelley/

Supervisory Patent Examiner

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/Hunter Lonsberry/

Primary Examiner